[2345/122]

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Joerg SCHWENK et al.

Serial No. : 09/529,644

Filed : April 17, 2000

For : METHOD AND DEVICE FOR ROUTING OF

SPECIFIC DATA, PARTICULARLY RECEIVING

RIGHTS, IN A PAY-TV TERMINAL

Art Unit : 2611

Examiner : Andrew Y. Koenig

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

Date Child 8, 2006

Signature: Linda M. Shudy (Reg. No. 47,084)

TRANSMITTAL OF AMENDMENT AND REQUEST FOR EXTENSION

SIR:

Transmitted herewith for filing in the above-identified patent application is an Amendment.

This is also a Request under 37 C.F.R. § 1.136(a) to extend the three-month response date by two months from February 18, 2006 to April 18, 2006.

The Commissioner is authorized to charge the appropriate fee, which is believed to be \$450.00 (for the two-month extension), to Deposit Account No. 11-0600, and is also authorized, as appropriate and/or necessary, to charge any additional fees (including any Rule 136(a) extension fees, extra claim fees, etc.) or credit any overpayment to Deposit Account No. 11-0600. A duplicate copy of this transmittal letter is enclosed for that purpose.

Bv:

Respectfully submitted,

Dated: 4 200

Richard L. Mayer (Reg. No. 22,490)

KENYON & KENYON LLP

One Broadway

New York, New York 10004 (212) 425-7200 (telephone) (212) 425-5288 (facsimile)

CUSTOMER NO. 26646



United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO. FILING DATE		FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO	
09/529,644 04/17/2000		04/17/2000	JOERG SCHWENK	2345/122	8596	
26646	7590	06/02/2006		EXAM	INER	
KENYON & KENYON LLP ONE BROADWAY				KOENIG, ANDREW Y		
NEW YO				ART UNIT	PAPER NUMBER	
				2623		
				DATE MAILED: 06/02/2006	5	

Please find below and/or attached an Office communication concerning this application or proceeding.

	•	Application No.	Applicant(s)	
,		09/529,644	SCHWENK ET	TAL.
Notice of Aba	andonment	Examiner	Art Unit	
		Andrew Y. Koenig	2623	
The MAILING DATE	of this communication	appears on the cover sheet w		nddress
			•	
This application is abandoned in	view of:			
period for reply (includir	n (with a Certificate ng a total extension of time	of Mailing or Transmission date of month(s)) which expi	d), which is after th red on	
		loes not constitute a proper reply		
application in condition	7 CFR 1.113 to a final rejo for allowance; (2) a timely (RCE) in compliance with	ection consists only of: (1) a time r filed Notice of Appeal (with appo r 37 CFR 1.114).	ly filed amendment which peal fee); or (3) a timely filed	places the d Request for
(c) ☐ A reply was received or final rejection. See 37 (n but it does not co CFR 1.85(a) and 1.111.(nstitute a proper reply, or a bona See explanation in box 7 below).	i fide attempt at a proper re	eply, to the non-
(d) No reply has been recei	ived.			
Applicant's failure to timely from the mailing date of the	pay the required issue fe Notice of Allowance (PT	e and publication fee, if applicabl OL-85).	le, within the statutory perio	od of three months
(a) The issue fee and pub	lication fee, if applicable	was received on (with a pry period for payment of the issued to the instance of the inst	a Certificate of Mailing or ue fee (and publication fee)	Transmission dated set in the Notice of
(b) ☐ The submitted fee of \$_	is insufficient. A ba	lance of \$ is due.		
The issue fee required	d by 37 CFR 1.18 is \$	The publication fee, if require	ed by 37 CFR 1.18(d), is \$	·
(c) The issue fee and public	cation fee, if applicable, h	as not been received.		
3. Applicant's failure to timely Allowability (PTO-37).				•
(a) Proposed corrected dra after the expiration of th		(with a Certificate of Mailin	g or Transmission dated _), which is
(b) No corrected drawings	have been received.			
The letter of express abance the applicants.	donment which is signed t	by the attorney or agent of record	I, the assignee of the entire	e interest, or all of
5. The letter of express abance 1.34(a)) upon the filing of a		by an attorney or agent (acting in	a representative capacity	under 37 CFR
6. The decision by the Board of the decision has expired			d because the period for s	eeking court review
7. The reason(s) below:	ANDREN Y VOE AV 7623			
	AUDRON Y KOE	w167		
	AU 7623			
Petitions to revive under 37 CFR 1.1 minimize any negative effects on pat	37(a) or (b), or requests to went term.	ithdraw the holding of abandonment	under 37 CFR 1.181, should l	be promptly filed to
.S. Patent and Trademark Office PTOL-1432 (Rev. 04-01)	No	tice of Abandonment	Part of F	Paper No. 20060530



Title: METHOD AND DEVICE FOR RELAYING SPECIFIC DATA, ESPECIALLY RECEIVING RIGHTS, TO A PAY TELEVISION TERMINAL Matter: 122 Client: 02345 Application No: 09/529644 (P33150 USW 0 58130)



United States Patent and Trademark Office

UNITED STATES DEPARTMENT OF COMMERCE United States Patent and Trademark Office Address: COMMISSIONER FOR PATENTS P.O. Box 1450 Alexandria, Virginia 22313-1450 www.uspto.gov

APPLICATION NO.	FII	LING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/529,644	0	04/17/2000	JOERG SCHWENK	2345/122	8596
26646	7590	11/18/2005		EXAM	INER
KENYON & KENYON				KOENIG, A	NDREW Y
ONE BROA		004		ART UNIT	PAPER NUMBER
NEW TOK	ic, 141 10	.004		2611	
				D. MD. V. V. DD. 11/10/200	_

DATE MAILED: 11/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
		09/529,644	SCHWENK ET AL.
	Office Action Summary	Examiner	Art Unit
	•		
	The MAILING DATE of this communication app	Andrew Y. Koenig	2611 correspondence address
Period fo			·
WHIC - Exter after - If NC - Failu Any	ORTENED STATUTORY PERIOD FOR REPLY CHEVER IS LONGER, FROM THE MAILING DATE of time may be available under the provisions of 37 CFR 1.13 SIX (6) MONTHS from the mailing date of this communication. It is period for reply is specified above, the maximum statutory period were to reply within the set or extended period for reply will, by statute, reply received by the Office later than three months after the mailing end patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be time iii apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE!	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).
Status			
1)🛛	Responsive to communication(s) filed on 22 Au	ugust 2005.	
2a) <u></u> ☐	This action is FINAL . 2b)⊠ This	action is non-final.	
3)□	Since this application is in condition for allowar	·	
	closed in accordance with the practice under E	x parte Quayle, 1935 C.D. 11, 45	3 O.G. 213.
Disposit	ion of Claims		
5)⊠ 6)⊠ 7)⊠	Claim(s) <u>15-33</u> is/are pending in the application 4a) Of the above claim(s) is/are withdraw Claim(s) <u>32</u> is/are allowed. Claim(s) <u>15-22,24-31 and 33</u> is/are rejected. Claim(s) <u>23</u> is/are objected to. Claim(s) are subject to restriction and/or	vn from consideration.	
Applicati	ion Papers		
9)□ 10)□	The specification is objected to by the Examine The drawing(s) filed on is/are: a) access applicant may not request that any objection to the Replacement drawing sheet(s) including the correct The oath or declaration is objected to by the Example 2.	epted or b) objected to by the liderawing(s) be held in abeyance. See ion is required if the drawing(s) is obj	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).
Priority (ınder 35 U.S.C. § 119		
12) <u>□</u> a)l	Acknowledgment is made of a claim for foreign All b) Some * c) None of: 1. Certified copies of the priority documents 2. Certified copies of the priority documents 3. Copies of the certified copies of the priority application from the International Bureau See the attached detailed Office action for a list	s have been received. s have been received in Applicati rity documents have been receive u (PCT Rule 17.2(a)).	on No ed in this National Stage
2) Notice 3) Information	t(s) te of References Cited (PTO-892) te of Draftsperson's Patent Drawing Review (PTO-948) mation Disclosure Statement(s) (PTO-1449 or PTO/SB/08) r No(s)/Mail Date	4) Interview Summary Paper No(s)/Mail Da 5) Notice of Informal P 6) Other:	

Art Unit: 2611

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 15-33 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

- 2. Claim 23 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
- 3. Claim 32 is allowed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- 5. Claims 15-18 and 20-22 are rejected under 35 U.S.C. 102(a) as being anticipated by GB 2311 451 to Tsuria.

Regarding claim 15, Tsuria teaches transmitting data from a headend (claimed transmitter) via a pay TV network (which inherently has a transmission medium in order to transmit the information) to the decoder (claimed the pay TV terminal) (pg. 11, II. 5-14, pg. 15, II. 17-20). Tsuria teaches receiving the data from the pay TV network, which

Art Unit: 2611

inherently buffers the data at the decoder in order to reactivate another card (pg. 15, II. 17-20). Tsuria teaches inserting the first and second smart cards into the decoders (as shown in figure 2A-2B), which inherently must establish at least an electrical communication between the smart cards and the pay TV terminal. Tsuria teaches routing the deactivation codes (which equates to the claimed receiving rights in the mobile data carrier) from the decoder to the smart card, wherein the data includes at least second receiving rights for a second smart card (claimed second mobile data carrier) (pg. 15, II. 17-20).

Regarding claim 16, Tsuria teaches smart cards (pg. 11, II. 5-19).

Regarding claim 17, Tsuria teaches transmitting data from a headend (claimed transmitter) via a pay TV network (which inherently has a transmission medium in order to transmit the information) to the decoder (claimed the pay TV terminal) (pg. 11, ll. 5-14, pg. 15, ll. 17-20). Tsuria teaches receiving the data from the pay TV network, which inherently buffers the data at the decoder in order to reactivate another card (pg. 15, ll. 17-20). Tsuria teaches inserting the first and second smart cards into the decoders (as shown in figure 2A-2B), which inherently must establish at least an electrical communication between the smart cards and the pay TV terminal. Tsuria teaches routing the deactivation codes (which equates to the claimed receiving rights in the mobile data carrier) from the decoder to the smart card, wherein the data includes at least second receiving rights for a second smart card (claimed second mobile data carrier) (pg. 15, ll. 17-20).

4

Tsuria teaches validating, identifying, verifying, and authenticating the second smart card (pg. 15, II. 3-5), wherein both cards get the same list of filters, which equates to storing a list of a respective chipcard number and respective filter information, further Tsuria teaches a smart card that enables the pay-TV terminal to cooperate with both the first and second smart card (pg. 12, II. 20-22).

Regarding claim 18, Tsuria inherently teaches a list that has a length or composition that is either variable or fixed in that all list are either variable or fixed lengths.

Regarding claim 20, Tsuria teaches inserting cards (as shown in fig. 2A-2B), which equates to the claimed storing is performed manually.

Regarding claim 21, Tsuria teaches transmitting the chipcard numbers and respective filter information to the pay-TV terminal via the transmission medium (pg. 15, ll. 17-20).

Regarding claim 22, Tsuria teaches upon inserting a card transferring information (pg. 14-15, II. 14-2), which equates to transmitting filter information the terminal uting the smart card upon establishing a communication between the terminal and smart card.

Claim Rejections - 35 USC § 103

- 6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 2611

7. Claims 19, 24-31, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2311 451 to Tsuria in view of WO 96/07267 to Chaney.

Regarding claim 19, Tsuria teaches is silent on automatically storing the rules using the pay-TV terminal. In analogous art, Chaney teaches storing EMMs upon receipt into the pay-TV terminal and storing the data into the EEPROM of the smart card (pg. 11, II. 21-29). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tsuria by automatically storing the rules using the pay-TV terminal as taught by Chaney in order to enable the system to add and delete entitlements to services.

Regarding claim 24, Tsuria teaches transmitting data from a headend via a pay TV network (which inherently has communication apparatus in order to receive transmitted information) to the decoder (claimed the pay TV terminal) (pg. 11, II. 5-14, pg. 15, II. 17-20). Tsuria teaches receiving the data from the pay TV network, which inherently buffers the data in memory at the decoder in order to reactivate another card (pg. 15, II. 17-20). Tsuria teaches inserting the first and second smart cards into the decoders (as shown in figure 2A-2B), which inherently must establish at least an electrical communication between the smart cards and the pay TV terminal. Tsuria teaches routing the deactivation codes (which equates to the claimed receiving rights in the mobile data carrier) from the decoder to the smart card, wherein the data includes at least second receiving rights for a second smart card (claimed second mobile data carrier) (pg. 15, II. 17-20). Tsuria teaches sending receiving information to the smart

Art Unit: 2611

cards but is silent on control and evaluation electronics. Chaney teaches a security controller 183 for processing EMM and ECM data and providing entitlement information (pg. 10, II. 3-19, pg. 11, II. 21-29), which equates to a control and evaluation electronics. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tsuria by incorporating control and evaluation electronics as taught by Chaney in order to facilitate processing of the entitlement messages thereby ensuring that the system accesses desirable programming.

Regarding claim 25, Tsuria teaches pay TV terminals (pg. 10, II. 6-14).

Regarding claim 26, Tsuria teaches smart cards (pg. 11, II. 5-19).

Regarding claim 27, Tsuria teaches activating and deactivating(pg. 14, II. 14-20, pg. 15, II. 17-20).

Regarding claim 28, the combination of Tsuria and Chaney is addressed in the discussion of claim 24, the combination of Tsuria and Chaney teaches storing EMM data in EEPROM (Chaney: pg. 11, II. 21-29), which is non-volatile memory.

Regarding claim 29, the combination of Tsuria and Chaney is addressed in the discussion of claim 24, the combination of Tsuria and Chaney teaches storing EMM data in EEPROM (Chaney: pg. 11, II. 21-29)

Regarding claim 30, Tsuria teaches transmitting data from a headend via a pay TV network (which inherently has communication apparatus in order to receive transmitted information) to the decoder (claimed the pay TV terminal) (pg. 11, II. 5-14, pg. 15, II. 17-20). Tsuria teaches receiving the data from the pay TV network, which

Art Unit: 2611

inherently buffers the data in memory at the decoder in order to reactivate another card (pg. 15, II. 17-20). Tsuria teaches inserting the first and second smart cards into the decoders (as shown in figure 2A-2B), which inherently must establish at least an electrical communication between the smart cards and the pay TV terminal. Tsuria teaches routing the deactivation codes (which equates to the claimed performing an allocation respectively between the first and second portion of the buffered data and the first and second mobile carriers) from the decoder to the smart card, wherein the data includes at least second receiving rights for a second smart card (pg. 15, II. 17-20).

Tsuria teaches sending receiving information to the smart cards but is silent on control and evaluation electronics. Chaney teaches a security controller 183 for processing EMM and ECM data and providing entitlement information (pg. 10, II. 3-19, pg. 11, II. 21-29), which equates to a control and evaluation electronics. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tsuria by incorporating control and evaluation electronics as taught by Chaney in order to facilitate processing of the entitlement messages thereby ensuring that the system accesses desirable programming.

Tsuria teaches validating, identifying, verifying, and authenticating the second smart card (pg. 15, II. 3-5), wherein both cards get the same list of filters, which equates to storing a list of a respective chipcard number and respective filter information, further Tsuria teaches a smart card that enables the pay-TV terminal to cooperate with both the first and second smart card (pg. 12, II. 20-22).

Art Unit: 2611

Regarding claim 31, Tsuria teaches transmitting data from a headend via a pay TV network (which inherently has communication apparatus in order to receive transmitted information) to the decoder (claimed the pay TV terminal) (pg. 11, ll. 5-14, pg. 15, II. 17-20). Tsuria teaches receiving the data from the pay TV network, which inherently buffers the data in memory at the decoder in order to reactivate another card (pg. 15, II. 17-20). Tsuria teaches inserting the first and second smart cards into the decoders (as shown in figure 2A-2B), which inherently must establish at least an electrical communication between the smart cards and the pay TV terminal. Tsuria teaches routing the deactivation codes (which equates to the claimed receiving rights in the mobile data carrier) from the decoder to the smart card, wherein the data includes at least second receiving rights for a second smart card (claimed second mobile data carrier) (pg. 15, ll. 17-20). Tsuria teaches sending receiving information to the smart cards but is silent on control and evaluation electronics. Change teaches a security controller 183 for processing EMM and ECM data and providing entitlement information (pg. 10, II. 3-19, pg. 11, II. 21-29), which equates to a control and evaluation electronics. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tsuria by incorporating control and evaluation electronics as taught by Chaney in order to facilitate processing of the entitlement messages thereby ensuring that the system accesses desirable programming.

Tsuria teaches routing the deactivation codes (which equates to the claimed receiving rights in the mobile data carrier) from the decoder to the smart card, wherein the data includes at least second receiving rights for a second smart card (claimed

Art Unit: 2611

second mobile data carrier) (pg. 15, ll. 17-20) and Tsuria teaches validating, identifying, verifying, and authenticating the second smart card (pg. 15, ll. 3-5), which equates to determining which of the data carriers is in communication with the terminal to enable respective routing of the activation codes,

Regarding claim 33, Tsuria teaches transmitting data from a headend via a pay TV network (which inherently has communication apparatus in order to receive transmitted information) to the decoder (claimed the pay TV terminal) (pg. 11, ll. 5-14, pg. 15, II. 17-20). Tsuria teaches receiving the data from the pay TV network, which inherently buffers the data in memory at the decoder in order to reactivate another card (pg. 15, II. 17-20). Tsuria teaches inserting the first and second smart cards into the decoders (as shown in figure 2A-2B), which inherently must establish at least an electrical communication between the smart cards and the pay TV terminal. Tsuria teaches routing the deactivation codes (which equates to the claimed receiving rights in the mobile data carrier) from the decoder to the smart card, wherein the data includes at least second receiving rights for a second smart card (claimed second mobile data carrier) (pg. 15, II. 17-20). Tsuria teaches sending receiving information to the smart cards but is silent on control and evaluation electronics. Change teaches a security controller 183 for processing EMM and ECM data and providing entitlement information (pg. 10, II. 3-19, pg. 11, II. 21-29), which equates to a control and evaluation electronics. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Tsuria by incorporating control and evaluation electronics

Art Unit: 2611

as taught by Chaney in order to facilitate processing of the entitlement messages thereby ensuring that the system accesses desirable programming.

Tsuria teaches routing the deactivation codes (which equates to the claimed receiving rights in the mobile data carrier) from the decoder to the smart card, wherein the data includes at least second receiving rights for a second smart card (claimed second mobile data carrier) (pg. 15, II. 17-20).

Tsuria teaches validating, identifying, verifying, and authenticating the second smart card (pg. 15, II. 3-5), wherein both cards get the same list of filters, which equates to storing a list of a respective chipcard number and respective filter information, further Tsuria teaches a smart card that enables the pay-TV terminal to cooperate with both the first and second smart card (pg. 12, II. 20-22).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Y. Koenig whose telephone number is (571) 272-7296. The examiner can normally be reached on M-Th (7:30 - 6:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2611

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ayk

Notice of References Cited

Application/ControPNE
09/529,644

Examiner JUN 0 4 2007 y
Andrew Y. Caenig

Applicant(s)/Patent Under Reexamination SCHWENK ET AL.

Art Unit 2611

Page 1 of 1

U.S. PATENT DOCUMENTS THADE

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
	Α	US-			
	В	US-			
	С	US-			
	D	US-			
	E	US-			
	F	US-			
	·G	US-			
	Н	US-			
	ı	US-		_	
	J	US-			
	к	US-			
	L	US-			
	М	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	GB 2311451 A	09-1997	United Kingdom	TSURIA, YOSSEF	H04N 07/16
	0	WO 9607267 A2	03-1996	World Intellect	CHANEY, J W	G06K 19/07
	Р					
	Q					
	R					
	s					
	Т					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	٧	
	w	
	×	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).) Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.



Title: METHOD AND DEVICE FOR RELAYING SPECIFIC DATA, ESPECIALLY RECEIVING RIGHTS, TO A PAY TELEVISION TERMINAL Matter: 122 Client: 02345 Application No: 09/529644 (P33150 USW 0 42152)

